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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,738	01/27/2004	James M. McDonough	APD-001	1102
34203	7590	10/27/2005	EXAMINER	
Michael L. Leetzow, Esq. Michael L. Leetzow, P.A. 5213 SHORELINE CIRCLE SANFORD, FL 32771			WONG, STEVEN B	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/765,738	Applicant(s) MCDONOUGH ET AL.	
	Examiner Steven Wong	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 10-19 is/are rejected.
- 7) ☒ Claim(s) 3,4 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 17 recites the limitation "the shaft". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 2, 5-7, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase (3,414,268). Note the basis for the rejections set forth in the Office Actions mailed December 2, 2004 and May 16, 2005.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (3,414,268). Note the basis for the rejections set forth in the Office Actions mailed December 2, 2004 and May 16, 2005.
8. Claims 12 and 14-16 is rejected under 35 U.S.C 103(a) as being unpatentable over Chase (3,414,268) in view of Andrikian (5,383,668). Note the basis for the rejections set forth in the

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Office Actions mailed December 2, 2004 and May 16, 2005. Regarding claim 14, the added limitation for the enlarged base to have a flat bottom and the shaft to be substantially smaller in diameter than the enlarged base is taught by the reference to Andrikian.

9. Claims 17-19 are rejected under 35 U.S.C 103(a) as being unpatentable over Clausing (1,644,979) in view of Patterson (5,301,950). Regarding claim 17, Clausing discloses a golf tee comprising a shaft (1), a top portion (6), a plurality of legs (7) extending from the top portion and web members (generally denoted as element 10) extending between the leg members. Note the Figures of Clausing showing the teed ball only contacting the legs and not the seat of the top portion. However, Clausing lacks the particular method steps for teeing the golf ball.

Patterson reveals that it is well known in the art of golf tees to tee a golf ball by pushing the ball against the tee and urging the golf ball up and onto the tee's golf ball seat. It would have been obvious to one of ordinary skill in the art to tee a golf ball on the tee of Clausing by pushing the golf ball to the tee of Clausing and then urging the ball between the legs and up onto the tee in order to tee a golf ball without bending down.

Regarding claim 18, it would have been obvious to one of ordinary skill in the art to replace the sharpened point of Clausing with an enlarged base as taught by Patterson in order to allow the tee to be used with a golf driving mat. The tee of Clausing provides a top portion that extends radially outwardly from the shaft.

Regarding claim 19, Clausing provides four legs.

10. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson (5,301,950). Regarding the added limitation to claim 18, attention is directed to Figures 5 and 6 showing a portion (38a, 38b) of thickened diameter that extends outwardly from

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the shaft. Patterson is seen as teaching a shaft extending from the base (20) and a top portion comprising the web member (32) and legs (30) which is connected to the shaft.

Allowable Subject Matter

11. Claims 3, 4 and 9 read over the prior art of record.

Response to Arguments

12. Applicant's arguments filed August 16, 2005 have been fully considered but are not deemed to be persuasive. Regarding the applicant's argument that the web member (as indicated by the examiner's notations in the Office Action mailed May 16, 2005) is dependent on the shaft, this argument is not persuasive as the web member is not directly connected to the shaft and is therefore, not dependent. Attention is directed to Figures 1 and 2 where Figure 1 shows the web member and Figures 2 shows an element (16) that extends therefrom and contacts the shaft (15A). Thus, the web member is separate and therefore independent of the shaft (15A).

Regarding the applicant's remarks stating that, according to the examiner's interpretation, if the legs are connected to the shaft then the web members must also be connected, this argument is also not persuasive. Instant claim 1 is anticipated by the arrangement of Chase as it nowhere does it state that the legs must be directly connected to the shaft. The legs (17) are indeed connected to the shaft (15A) via the bore (16). It is also noted that the claim utilizes the open language "comprising", thus, permitting the inclusion of additional structural members there between.

Regarding the remarks directed to claim 14, the added limitation for the base to have a flat bottom and the shaft to have a smaller diameter than the base is taught by the secondary reference to Andrikian.

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Regarding the applicant's argument that the standard for combining references is not whether the disclosures would preclude the modification as recited, the examiner is well aware of the standard for combining references. Applicant is again directed to the rejection of claim 12 stating that it would have been obvious to one of ordinary skill in the art to form the tee of Chase with an enlarged base in order to allow the tee to be used in a driving range environment. The argument that nothing in the disclosures would preclude the modification as recited was merely made in order to demonstrate to applicant that nothing in either of the disclosures is seen as teaching away from one another.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's remarks requesting an appropriate affidavit is unclear as nowhere is it seen in the Office Action that the examiner is relying upon his own personal knowledge.

Regarding the applicant's remarks that the combination of Chase in view of Andrikian would provide a golf tee without a shaft and merely the top portion, this argument is also not persuasive. Both references teach a shaft connected to a top portion for teeing a ball. Both references teach ground engagement means for stably supporting the top portion and ball thereupon. It would have been obvious to one of ordinary skill in the art to eliminate the pointed

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portion of the shaft of Chase and replace it with the enlarged base portion of Andrikian in order to allow the tee to be used in a driving range environment.

Regarding the remarks directed to claim 17, attention is directed to the rejection under 35 U.S.C. 112, second paragraph. The added limitation for “the shaft” lacks a proper antecedent basis within the claim. Also, the rejection has been changed to include the reference to Clausing. Clausing teaches a golf tee comprising a plurality of legs such that a teed golf ball rests only on the legs (note Figures). Given the teachings of Patterson that it is well known in the art to push a golf ball to a tee and urge the golf ball up and onto the tee, it would have been obvious to one of ordinary skill in the art to push and urge a golf ball onto the tee of Clausing in order to reduce the amount of bending over by the golfer. Further, the only location that this method could be accomplished on the tee of Clausing would be between two of the legs.

Regarding claim 18, the applicant argues that Patterson lacks the teaching for a top portion that extends at least partially outwardly in a radial direction from the shaft. However, this is not persuasive as the top portion of Patterson includes a portion (38A, 38B) that extends beyond the radial diameter of the shaft. It is also noted that claim 18 is now rejected over the combination of Clausing in view of Patterson.

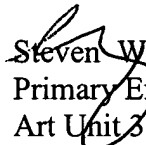
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
October 25, 2005